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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,657	12/08/2003	Srikanth Karimisetty	021756-001900US	4952
51206 7590 07/09/2008 TOWNSEND AND TOWNSEND AND CREW LLP TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
POWERS, WILLIAM S				
ART UNIT		PAPER NUMBER		
2134				
NOTIFICATION DATE		DELIVERY MODE		
07/09/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Office Action Summary

Application No.

10/731,657

Applicant(s)

KARIMISETTY ET AL.

Examiner

WILLIAM S. POWERS

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-22 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/21/2008 has been entered.

Response to Arguments

2. As to Applicant's argument that, "the alleged event of the legal transaction does not occur (e.g., become binding and legally enforcing) until after creation of the electronic document. In contrast, amended claim 1 recites that the event occurs before creation of the electronic record as occurrence of the event creates the electronic document" (Remarks, page 10, lines 14-18), the Examiner respectfully disagrees. The Applicant appears to limit "an event" to the signing of an electronic document, in which case the electronic document would necessarily have to come first. The Examiner interprets the claim limitations in the broadest, reasonable interpretation and sees that the event of the claim is not limited to the signing of a document as suggested by the Applicant. It is pointed out the Examiner uses the land transaction as only one example of an embodiment of the patent of Slater. Other examples of potential uses of the patent

include at least applying for business licenses, vehicle licenses, hunting and fishing licenses, court filings, insurance claims as can be seen from col. 4, lines 53-64 of the patent. Information needed to prepare the electronic document comprises at least: the required signature(s) of person(s) named in the document and whether or not a notary is required. For simplicity, the Examiner continues using the example of a land transaction, but this example should not be considered to be limiting. As noted above, the information used in preparing a land transaction not only defines a land transaction, but also describes the parties involved in the land transaction and the signature(s) needed on the electronic document. The Examiner views the event as the "signing ceremony" or the coming together of the participants to review and sign the electronic document. For at least the reasons above, the rejections to the claims are maintained.

3. As to Applicant's argument that, "Slater does not define an event that upon occurrence generates an electronic record from data intercepted from a database transaction" (Remarks, page 10, lines 19-21), the Examiner respectfully disagrees. As shown in at least col. 7, lines 5-13, Slater shows that entering data into a template. Although not explicitly mentioned in the patent, it is inherent that the template of Slater is stored in memory and retrieved when necessary. Using the broadest, reasonable interpretation of the claims as written, the Examiner sees the retrieval and use of a template from memory as equivalent to the limitations added by amendment. For at least the reasons above, the art of record overcomes the added limitations of "data intercepted from a database transaction."

4. Applicant's argument directed to page 4 of the Final Office Action have been addressed above.
5. As to Applicant's argument that, "The first information and the electronic record are distinctly recited in claim 1, and thus the same electronic document in Slater fails to teach or suggest both as recited in claim 1" (Remarks, page 11, lines 10-11), the Examiner respectfully disagrees. It appears that the Applicant is arguing that the first information cannot be part of the electronic record. It is noted that the features upon which applicant relies (i.e., first information and the electronic record are distinct) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). For at least the reasons above, the rejection to the claims is maintained.

Response to Amendment

6. The Examiner has stated the below column and line numbers as examples. All columns and line numbers in the reference and the figures are relevant material and Applicant should be taken the entire reference into consideration upon the reply to this Office Action.
7. Claims 1, 9 and 17 have been amended.
8. Claims 1-22 are pending.

Claim Rejections - 35 USC § 112

9. In light of Applicant's amendments and arguments, the previous 35 USC 112, 1st paragraph rejection of claims 1, 9 and 17 have been withdrawn.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 1-3, 5, 8, 9-11, 13, 16-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent no. 6,796,489 to Slater et al. (hereinafter Slater) in view of US Patent No. 6,807,633 to Pavlik.

As to claim 1 as best understood, Slater teaches:

- a. Receiving first information from a user interface defining an event that, upon occurrence, generates an electronic record that requires an electronic

signature from data intercepted from a database transaction (As noted above, the information used in preparing a land transaction, for example, not only defines a land transaction, but also describes the parties involved in the land transaction and the signature(s) needed on the electronic document. The Examiner views the event as the "signing ceremony" or the coming together of the participants to review and sign the electronic document. Using the broadest, reasonable interpretation of the claims as written, the Examiner sees the retrieval and use of a template from memory as equivalent to the limitation "from data intercepted from a database transaction.") (Slater, column 7, lines 5-16).

b. Receiving second information from a user interface defining one or more fields stored in the electronic record (document is prepared by the user through inputting data and content into a template and determining the signatures needed for the document) (Slater, column 7, lines 5-49 and column 9, lines 50-63).

c. Receiving third information from a user interface that maps data from the underlying database tables to at least some of the fields defined for the electronic record (using templates to store documents in databases and using optional verification module) (Slater, column 7, lines 5-49).

Slater does not expressly mention the physical layout of the document. However, in an analogous art, Pavlik teaches:

d. Receiving fourth information from a user interface defining a layout for displaying data in the electronic record on a computer display when an electronic signature for the data record is collected (user selects data items to be displayed

in the document according to position and orientation within the document)
(Pavlik, column 5, lines 43-53 and figure 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the electronic document scheme of Slater with the user defined layout of Pavlik in order to further customize the document template as illustrated in figures 2 and 3 of Pavlik.

Slater as modified further teaches:

- e. Receiving fifth information from a user interface identifying a signatory approver for the electronic record (document is signed by one or more persons indicated in the electronic document) (Slater, column 7, lines 15-17).
- f. In response to the occurrence of the event (a "signing ceremony" as described above) (Slater, column 10, lines 51-55), generating the electronic record from data intercepted from the database transaction (A document is prepared that requires one or more digital signatures and using the broadest, reasonable interpretation of the claims as written, the Examiner sees the retrieval and use of a template from memory as equivalent to the limitation "from data intercepted from a database transaction.) (Slater, column 7, lines 5-14) and displaying the electronic record to the signatory approver according to the defined layout (Slater, column 6, lines 38-40 and Pavlik, column 5, lines 16-21).
- g. Receiving an electronic signature from the signatory approver (Slater, column 7, lines 15-25).

h. Generating sixth information associating the electronic signature with the electronic record prior to committing the database transaction to a database (signatures are verified to ensure that the electronic document is in a suitable state of compliance to be saved) (Slater, column 8, lines 30-33).

As to claim 2 as best understood, Slater as modified teaches verifying the electronic signature prior to associating the electronic signature with the electronic record (signatures are verified to ensure that the electronic document is in a suitable state of compliance to be saved) (Slater, column 8, lines 30-33).

As to claim 3 as best understood, Slater as modified teaches associating the electronic signature with the electronic record comprises associating the electronic signature with the electronic record in response to a positive verification of the electronic signature (signatures are verified to ensure that the electronic document is in a suitable state of compliance to be saved) (Slater, column 8, lines 30-33).

As to claim 5 as best understood, Slater as modified teaches verifying the electronic signature and storing the electronic record in a common repository of electronic records that are generated from multiple data sources (once the recorder as verified the signatures the electronic document is stored in a database) (Slater, column 15, lines 17-32 and figure 5).

As to claim 8 as best understood, Slater as modified teaches determining that an electronic signature is required, displaying data from the electronic record on a computer display (According to claim 1, only electronic documents that require electronic signatures are generated so that any document generated by the invention requires a digital signature. The document is presented to each of the one or more signatories so that their respective digital signatures can be captured) (Slater, column 7, lines 14-25).

As to claim 9 as best understood, Slater as modified teaches:

- a. A processor (Slater, column 5, lines 59-67).
- b. A database (Slater, column 15, lines 17-32).
- c. A computer-readable memory coupled to the processor, the computer readable memory configured to store a computer program (Slater, column 6, lines 25-28).

The limitations (i)-(viii) are substantially similar to the limitations of claim 1 and are similarly rejected.

As to claim 10 as best understood, the limitations of the claim are substantially similar to the limitations of claim 2 and are similarly rejected.

As to claim 11 as best understood, the limitations of the claim are substantially similar to the limitations of claim 3 and are similarly rejected.

As to claim 13 as best understood, the limitations of the claim are substantially similar to the limitations of claim 5 and are similarly rejected.

As to claim 16 as best understood, the limitations of the claim are substantially similar to the limitations of claim 8 and are similarly rejected.

As to claim 17 as best understood, the limitations of the claim are a computer program product comprising the method steps of claim 1 and are similarly rejected.

As to claim 18 as best understood, the limitations of the claim are a computer program product comprising the method steps of claim 2 and are similarly rejected.

As to claim 20 as best understood, the limitations of the claim are a computer program product comprising the method steps of claim 5 and are similarly rejected.

14. Claim 4 and claim 12 and claim 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent no. 6,796,489 to Slater et al. (hereinafter Slater) in view of US Patent No. 6,807,633 to Pavlik as applied to claim 1 and claim 9 and claim 18 respectively above, and further in view of US Patent No. 5,434,917 to Naccache et al. (hereinafter Naccache).

As to claim 4 as best understood, Slater as modified does not expressly mention that the digital signature comprises a user id and a password. However, in an analogous art, Naccache teaches the electronic signature comprises a user id and a password (a digital signature scheme that incorporates a user id and password into the computation of a digital signature) (Naccache, column 3, lines 1-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the electronic document scheme of Slater as modified with the digital signature computation of Naccache in order to establish the identity of user as suggested by Naccache (Naccache, column 3, lines 12-14).

As to claim 12 as best understood, the limitations of the claim are substantially similar to the limitations of claim 4 and are similarly rejected.

As to claim 19 as best understood, the limitations of the claim are substantially similar to the limitations of claim 4 and are similarly rejected.

15. Claims 6 and 7 and claims 14 and 15 and claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent no. 6,796,489 to Slater et al. (hereinafter Slater) in view of US Patent No. 6,807,633 to Pavlik as applied to claim 5 and claim 13 and claim 20 above, and further in view of US Patent No. 6,584,459 to Chang et al. (hereinafter Chang).

As to claim 6 as best understood, Slater as modified does not expressly mention using character large object format. However, in an analogous art, Chang teaches the electronic record comprises unstructured data in a character large object (CLOB) format (storing XML documents in CLOB format) (Chang, column 10, lines 49-62).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the electronic document scheme of Slater as modified with the CLOB format storage scheme of Chang in order to store long XML documents as suggested Chang (Chang, column 10, lines 49-62).

As to claim 7 as best understood, Slater as modified teaches the common repository is a database and wherein the unstructured data is a well-formed XML document stored within a column of a table stored in the database (storage scheme for XML documents in a database) (Chang, column 14, lines 31-35).

As to claim 14 as best understood, the limitations of the claim are substantially similar to the limitations of claim 6 and are similarly rejected.

As to claim 15 as best understood, the limitations of the claim are substantially similar to the limitations of claim 7 and are similarly rejected.

As to claim 21 as best understood, the limitations of the claim are a computer program product comprising the method steps of claim 6 and are similarly rejected.

As to claim 22 as best understood, the limitations of the claim are a computer program product comprising the method steps of claim 7 and are similarly rejected.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM S. POWERS whose telephone number is (571)272-8573. The examiner can normally be reached on m-f 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on 571 272 3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. S. P./

William S. Powers

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Examiner, Art Unit 2134

Examiner
Art Unit 2134

7/3/2008

/Kambiz Zand/

Supervisory Patent Examiner, Art Unit 2134